UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT LESLIE VAN OOSTENBRUGGE,
PAULUS GEORGE MARIA DE BOT AND
ASTRID MATHILDA FERDINANDA DOBBELAAR

Appeal 2007-0341
Application 09/832,719
Technology Center 2100

Decided: July 16, 2007

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and LANCE LEONARD BARRY, *Administrative Patent Judges.*

BARRY, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. More specifically, he rejected claims 9-11 and 19 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,784,900 ("Dobronsky") and claims 1-8, 12-18, and 20 under 35 U.S.C. § 103(a) as obvious over Dobronsky and U.S. Patent

No. 5,778,187 ("Montiero"). The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

II. PRINCIPLES OF LAW

In an *ex parte* appeal, the Board "is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). To enable our review, copies of cited references are to be "placed in the application file . . . during the prosecution." M.P.E.P. § 707.05(a) (8th ed., rev. 4, Oct. 2005[1]). "To assist in providing copies of, or access to, references, the examiner should . . . [t]ype the citation of the references on form PTO-892, 'Notice of References Cited.'" *Id.*

III. ANALYSIS

Here, although the Examiner relies on a definition from the "Microsoft Computer Dictionary Fifth Edition," (Answer 20), no copy of the definition appears in the application file. Such a copy is needed for our review of the Examiner's rejections. Because of the omission, "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999).

[1] We cite to the version of the Manual of Patent Examining Procedure in effect at the time of the Examiner's Answer.

IV. CONCLUSION

For the aforementioned reasons, we remand the application to the Examiner to furnish a copy of the aforementioned definition and for any further action not inconsistent with the views expressed herein. Although the definition can be furnished without providing a new examiner's answer, any subsequent answer that the Examiner chooses to submit should be self-contained with respect to all rejections and arguments; no prior answer or Office action should be referenced or incorporated therein. Similarly, although furnishing the definition does not necessitate a new brief, any subsequent brief submitted by the Appellants should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

REMANDED

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